

REMARKS**Summary of the Office Action**

Claims 21, 23, 29-30 and 35-37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over alleged prior art that includes U.S. Patent No. 6,212,150 to *Inoue et al.*

(“*Inoue*”) in view of U.S. Patent No. 6,445,668 to *Sugiura et al.* (“*Sugiura*”).

Claim 22 stands rejected as being unpatentable over alleged prior art *Sugiura* in view of U.S. Patent No. 6,584,060 to *Oohchida et al.* (“*Oohchida*”).

Claims 29-30 and 35-37 stand rejected as being unpatentable over alleged prior art *Inoue* and *Sugiura* in view of U.S. Patent No. 6,057,953 to *Ang* (“*Ang*”).

Summary of the Response to the Office Action

The *Sugiura* reference should be removed as a reference because it does not qualify as prior art under §102. Accordingly, claims 21-23, 29-30 and 35-37 are presently pending for consideration.

All Claims Comply With 35 U.S.C. §103(a)

Claims 21-23, 29-30 and 35-37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over alleged prior art that includes *Inoue* in view of *Sugiura*. Claim 22 stands rejected as being unpatentable over alleged prior art *Sugiura* in view of *Oohchida*. Claims 29-30 and 35-37 stand rejected as being unpatentable over alleged prior art *Inoue* and *Sugiura* in view of *Ang*. Applicants respectfully traverse the rejections for the following reasons.

Sugiura is disqualified as prior art under 35 U.S.C. 103(c) because the presently claimed invention was entirely or wholly owned by the same organization (business entity) that owned *Sugiura*, at the time the claimed invention was made. See MPEP § 706.02(1)(2). *Sugiura* and the

invention claimed in this application were, at the time the invention was made, subject to an obligation of assignment to the same assignee, Pioneer Corporation. Thus, *Sugiura* may be removed as an alleged prior art reference.

Additionally, Applicants respectfully submit that neither *Inoue*, *Oochida*, nor *Ang* teaches or suggests at least “a focus error detecting optical element . . . [with] four sections provid[ing] astigmatism for the return light passing through the sections contiguous to said division lines so that the astigmatism in directions are rotated by 90° from each other about the optical path, while separating the return light into at least four paths; and a photodetector which has at least four spaced light receiving elements for receiving the separated return light each of which has contour lines corresponding to said division lines and is comprised of two light receiving areas divided by a bisect line extending substantially in parallel with one of the contour lines,” as recited in independent claim 21.

As recited in claim 21, each of the at least four light receiving elements of the photodetector has contour lines corresponding to the division lines of the focus error detecting optical element. Each light receiving element is comprised of two light receiving areas divided by a bisect line extending substantially in parallel with one of the contour lines. The bisect line extends corresponding to the direction perpendicular to the track extending direction of the optical recording medium. As noted above, these light receiving areas improve sensitivity of focusing as shown in FIGS. 13A-13E, and particularly as shown in FIGS. 13B and 13D of the application as filed. The 90° rotated spot images with astigmatism cross over the bisect line to switch to the two light receiving areas in response to defocusing states. In contrast, neither *Inoue*, *Oochida*, nor *Ang* teaches or suggests at least these features in the present invention.

The Office Action has not established a *prima facie* case of obviousness at least because more of *Sugiura*, *Inoue*, *Oochida*, or *Ang* teaches or suggests, whether alone or in combination, teach or suggest all the recited features of independent claim 21. As pointed out in M.P.E.P. § 2143.03, “[t]o establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art”. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). As such, Applicants respectfully assert that the third prong of *prima facie* obviousness has not been met. Therefore, Applicants respectfully request that all rejections under 35 U.S.C. § 103(a) should be withdrawn because the cited references of record do not teach or suggest each and every feature of independent claim 21.

Additionally, Applicants respectfully submit that dependent claims 22-23, 29-30 and 35-37 are also allowable insofar as they recite the patentable combinations of features recited in claim 21 as well as reciting additional features that further distinguish over the applied prior art.

CONCLUSION

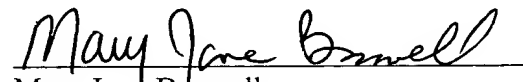
In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the response, the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,
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